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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/741,797

12/19/2003

Thomas E. Creamer

BOC9-2003-0111US1  
(1082-1)

5601

7590

05/05/2006

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EXAMINER

TIEU, BINH KIEN

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/741,797

Applicant(s)

CREAMER ET AL.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/16/2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding amended independent claims 1, 7 and 8, the claims are amended with element(s), e.g., call center, is not shown in the drawings and specification. According to the Applicants' Representative, Mr. Steven M. Greenberg, interviewed with Primary Examiner Barry Taylor ("Examiner Taylor") on February 21, 2006 on case serial number 10/918,063

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(hereinafter application'063), The Examiner Taylor, in the interview, suggested the Applicants to amend claims 1, 5 and 8 to include, inter alia, "a call center (coupled) on the other side of the PSTN" (see Telephone Summary, dated on 02/21/2006). The Examiner of the record carefully reviewed the drawing and the specification of the application '063, and found that the scope of the invention in application 10/741,797 (hereinafter application'797) is different from the scope of the invention in the application '063 because, in the application '797, the call center is *not* clearly disclosed in the specification as well as in drawings (e.g., drawing 1). In the application '063, the call center is clearly shown as element 160 in figure 1, and clearly illustrated on page 8 of the specification. But in the current application '797, it fails to disclose the call center in the drawing(s) as well as in the specification. The Applicants are requested to point out, wherein the specification and the drawings of application 10/741,797, teaches such the feature of "call center."

For the purpose of examinations, the Examiner assumed that claims 1, 7 and 8, at this point, in this Application were previously presented without any amendments with feature of "call center" as mentioned above. Also, in according to the Applicants argued in remarks filed 02/17/2006 in the Application 10/741,733, wherein the Applicants' arguments are moot against the applied Hanson reference. Therefore, the following Office Action is based on the status of claims 1, 7 and 8 previous presented and with a new ground rejection in view of new found reference to Dively et al. (Pub. No.: US 2002/0169719 A1).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable Scherer (US. Pat. #: 6,411,692) in view of Florida Citizens or Wisconsin or Digital launches industry, ***all above references were cited in the previous Office Action***), and further in view of Dively et al. (Pub. No.: 2002/0169719 A1).

Regarding claim 1, Scherer teaches a system for providing caller information to called party via standard data field comprising the steps of:

receiving a telephone call from a service subscriber over a PSTN in (see figures);

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identifying the service subscriber through identifying information received externally to the telephone call in (see col.8, col.10, lines 62-65, col.12, col.14, lines 28-36, col.23 "Example 1" and so forth; and

storing on a database through which external information can be retrieved, information including name, SSN, address and so forth;

retrieving service information for a service subscribed to by the subscriber based upon the identifying information;

Scherer fails to teach modifying a term of a subscription or renewing a subscription if payment can be provided, even though note payment information can be stored for car rentals and so forth.

Florida citizens are now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

Wisconsin is set to jump on the credit card bandwagon teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

Digital teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either primary reference into that of Scherer thus making it possible to extend or renew services without having to go the service provider in

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person, saving transportation cost, providing convenience and to able to use desired service before/after expiration.

It should be also noticed that Sherer, Florida, Wisconsin and Digital, all in combination, fails to clearly teach the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN. However, Dively et al. ("Dively") teaches electronic identifier payment systems and methods wherein the system comprises an interface 12 operates as a telephone or a POS device 110 as shown in figure 1B (see paragraph 53). Dively further teaches that a customer 190 can contacts with an agent network 160 using the interface 12, etc. a telephone, to proceed with a transaction. Dively teaches that the customer may enter information, such as identifier previous provided by the customer provider, for identifying payments via input device associated with the POS device 110. Customer information may be automatically received from database 135 to identify and to verify the customer external from the customer request for service (see paragraphs [0080]-[0082]).

Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to incorporate the teaching of the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN, as taught by Dively, into view of any combination of Sherer and Florida, Wisconsin or Digital in order to eliminate directing caller to select from one of several menu options and/or layers.

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Regarding claims 2-4, the combination including Scherer renders obvious the ability to retrieve name and address information from any database in any network environment in (see figs., cols. 7-12).

Regarding claims 5-6, the combination renders obvious the ability to renew or extend a service term.

Regarding claim 8, Scherer teaches a system for providing caller information to called party via standard data field comprising the steps of:

receiving a telephone call from a service subscriber over a PSTN in (see figures);

identifying the service subscriber through identifying information received externally to the telephone call in (see col. 8, col. 10 lines 62-65, col. 12, col. 14 lines 28-36, col. 23 "Example 1" and so forth; and

storing on the dataset through which external information can be retrieved, information including credit card information.

retrieving service information for a service subscribed by the service subscriber it taught by Scherer.

Scherer fails to teach modifying a term of a subscription or renewing a subscription if payment can be provided, even though note payment information can be stored for car rentals and so forth.

13/3, \*/3 teaches a Florida citizens now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.



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24/3, \*/9 teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

29/3 teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Scherer thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience and to able to use desired service before/after expiration.

It should be also noticed that Sherer, Florida, Wisconsin and Digital, all in combination, fails to clearly teach the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN. However, Dively teaches electronic identifier payment systems and methods wherein the system comprises an interface 12 operates as a telephone or a POS device 110 as shown in figure 1B (see paragraph 53). Dively further teaches that a customer 190 can contacts with an agent network 160 using the interface 12, etc. a telephone, to proceed with a transaction. Dively teaches that the customer may enter information, such as identifier previous provided by the customer provider, for identifying payments via input device associated with the POS device 110. Customer information may be automatically received from database 135 to identify and to verify the customer external from the customer request for service (see paragraphs [0080]-[0082]).

Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to incorporate the teaching of the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN, as taught by Dively, into view of any combination of Sherer and Florida, Wisconsin or Digital in order to eliminate directing caller to select from one of several menu options and/or layers.

Regarding claims 9-11, the combination including Scherer renders obvious the ability to retrieve name and address information from any database in any network environment in (see figs., cols. 7-12).

Regarding claims 12-13, the combination renders obvious the ability to renew or extend a service term based on cited secondary references.

6. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al. (US Pat# 6,744,877) in view of in view of 13/3, k/3 or 24/3, K/9 or 29/3, K/4 (*all references were also previously cited*), and further in view of Dively (Pub. No.: US 2002/0169719 A1).

Regarding claim 1, Edwards teaches an enterprise application system or service management system in (see fig.4, fig.6, fig.11, col.10, lines 25-30, col.11, lines 30-45, col.12, lines 27-40, col. 7, line 57 - col.18, line 8, col.20, lines 33-53, col.25, lines 30-50), comprising:

- establishing a telephone call with a service subscriber over a PSTN;
- receiving identifying information with the telephone call to identify the subscriber;
- correlating the identifying information with the telephone call to identify the subscriber;

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retrieving service information for a service subscribed by the subscriber and managing or providing services accordingly.

Edwards fails to teach being able to extend services or renew services using a telephone network.

13/3, k/3 teaches a Florida citizens now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

24/3, \*/9 teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

29/3 teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Scherer thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience and to able to use desired service before/after expiration.

It should be also noticed that Edwards 13/3, k/3 or 24/3, K/9 or 29/3, and k/4, in combination, fails to clearly teach the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN. However, Dively et al. ("Dively") teaches electronic identifier payment systems and methods wherein the system comprises an

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interface 12 operates as a telephone or a POS device 110 as shown in figure 1B (see paragraph 53). Dively further teaches that a customer 190 can contacts with an agent network 160 using the interface 12, etc. a telephone, to proceed with a transaction. Dively teaches that the customer may enter information, such as identifier previous provided by the customer provider, for identifying payments via input device associated with the POS device 110. Customer information may be automatically received from database 135 to identify and to verify the customer external from the customer request for service (see paragraphs [0080]-[0082]).

Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to incorporate the teaching of the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN, as taught by Dively, into view of any combination of Edwards 13/3, k/3 or 24/3, K/9 or 29/3, and k/4 in order to eliminate directing caller to select from one of several menu options and/or layers.

Regarding claims 2-4, the combination teaches being able to query a database for pertinent and would be obvious to use any conventionally known database system.

Regarding claims 5-6, the combination renders obvious the ability to extend or renew services.

Regarding claim 7, Edwards teaches a Service management system in (see fig.6, fig. 14) comprising of a name resolution unit communicatively linked to a database (see col. 17 lines 58-col. 18 line 8, col. 20), an enterprise application and a service logic associated with the enterprise application.

Edwards fails to teach being able to renew or extend a service over a telephony network.

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13/3, \*/3 teaches a Florida citizens now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

24/3, \*/9 teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

29/3 teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Edwards thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience without having to invest in expensive equipment such as a computer and to able to use desired service before/after expiration.

It should be also noticed that Edwards 13/3, k/3 or 24/3, K/9 or 29/3, and k/4, in combination, fails to clearly teach the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN. However, Dively et al. ("Dively") teaches electronic identifier payment systems and methods wherein the system comprises an interface 12 operates as a telephone or a POS device 110 as shown in figure 1B (see paragraph 53). Dively further teaches that a customer 190 can contacts with an agent network 160 using the interface 12, etc. a telephone, to proceed with a transaction. Dively teaches that the customer

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may enter information, such as identifier previous provided by the customer provider, for identifying payments via input device associated with the POS device 110. Customer information may be automatically received from database 135 to identify and to verify the customer external from the customer request for service (see paragraphs [0080]-[0082]).

Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to incorporate the teaching of the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN, as taught by Dively, into view of any combination of Edwards 13/3, k/3 or 24/3, K/9 or 29/3, and k/4 in order to eliminate directing caller to select from one of several menu options and/or layers.

Regarding claim 8, Edwards teaches an enterprise application system or service management system in (see fig.4, fig.6, fig.11, col.10, lines 25-30, col.11, lines 30-45, col.12, lines 27-40, col.17, line 57 - col.18, line 8, col.20, lines 33-53, col.25, lines 30-50) comprising:

- establishing a telephone call with a service subscriber over a PSTN;
- receiving identifying information with the telephone call to identify the subscriber;
- correlating the identifying information with the telephone call to identify the subscriber;
- retrieving service information for a service subscribed by the subscriber and managing or providing services accordingly.

Edwards fails to teach being able to extend services 'or renew services using a telephone network.

13/3, k/3 teaches a Florida citizens now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

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29/3 teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Edwards thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience without having to invest in expensive equipment such as a computer and to able to use desired service before/after expiration.

It should be also noticed that Edwards 13/3, k/3 or 24/3, K/9 or 29/3, and k/4, in combination, fails to clearly teach the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN. However, Dively et al. ("Dively") teaches electronic identifier payment systems and methods wherein the system comprises an interface 12 operates as a telephone or a POS device 110 as shown in figure 1B (see paragraph 53). Dively further teaches that a customer 190 can contacts with an agent network 160 using the interface 12, etc. a telephone, to proceed with a transaction. Dively teaches that the customer

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may enter information, such as identifier previous provided by the customer provider, for identifying payments via input device associated with the POS device 110. Customer information may be automatically received from database 135 to identify and to verify the customer external from the customer request for service (see paragraphs [0080]-[0082]).

Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to incorporate the teaching of the feature of receiving identifying information for said service subscriber, externally from said established telephone call, through a computer communications network from a switch in said PSTN, as taught by Dively, into view of any combination of Edwards 13/3, k/3 or 24/3, K/9 or 29/3, and k/4 in order to eliminate directing caller to select from one of several menu options and/or layers.

Regarding claims 9-13, see the previous explanation as set forth regarding these claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (571) 272-7510 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (571) 272-7499 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

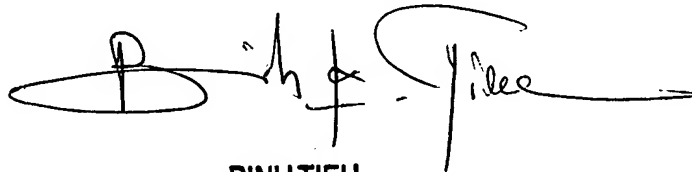
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A handwritten signature in black ink, appearing to read 'Binh Tieu', with a large, stylized initial 'B' and a long horizontal stroke extending to the right.

**BINH TIEU**  
**PRIMARY EXAMINER**

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Date: May 01, 2006